

TO: **Mail Stop 8**
Director of the U.S. Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

REPORT ON THE
FILING OR DETERMINATION OF AN
ACTION REGARDING A PATENT OR
TRADEMARK

SOLICITOR

In Compliance with 35 § 290 and/or 15 U.S.C. § 11208 you are hereby advised that a court action has been
 filed in the U.S. District Court Northern District of California on the following Patents or Trademarks:

DOCKET NO.	DATE FILED	U.S. PATENT & TRADEMARK OFFICE	U.S. DISTRICT COURT
CV 08-02050 MEJ	4/18/08		Northern District of California, San Francisco Division
PLAINTIFF		DEFENDANT	
TINY PRINTS, INC.		SHUTTERFLY, INC.	
PATENT OR TRADEMARK NO. DATE OF PATENT OR TRADEMARK HOLDER OF PATENT OR TRADEMARK			
1 6,583,852			
2 6,587,596			
3 7,146,575			
4 6,657,702			
5 6,278,528			

In the above—entitled case, the following patent(s) have been included:

DATE INCLUDED	INCLUDED BY	<input type="checkbox"/> Amendment	<input type="checkbox"/> Answer	<input type="checkbox"/> Cross Bill	<input type="checkbox"/> Other Pleading
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK			
1 6,533,169					
2 6,332,146					
3 6,704,712					
4 7,328,173					
5					

In the above—entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT

CLERK	(BY) DEPUTY CLERK	DATE
Richard W. Wiekking	Gloria Acevedo	April 23, 2008

Copy 1—Upon initiation of action, mail this copy to Commissioner Copy 3—Upon termination of action, mail this copy to Commissioner
 Copy 2—Upon filing document adding patent(s), mail this copy to Commissioner Copy 4—Case file copy

1 MATTHEW D. POWERS (Bar No. 104795)
matthew.powers@weil.com
2 CHRISTOPHER J. COX (Bar No. 151650)
chris.cox@weil.com
3 JOSEPH H. LEE (Bar No. 248046)
joseph.lee@weil.com
4 WEIL, GOTSHAL & MANGES LLP
Silicon Valley Office
5 201 Redwood Shores Parkway
Redwood Shores, CA 94065
6 Telephone: (650) 802-3000
Facsimile: (650) 802-3100
7
8 Attorneys for Plaintiff
Tiny Prints, Inc.

E-FILING

APR 18 2008
Richard W. Wieking
Clerk, U.S. District Court
Northern District of California
San Jose

ADR

9
10 UNITED STATES DISTRICT COURT
11 NORTHERN DISTRICT OF CALIFORNIA
12 SAN JOSE DIVISION

13 Tiny Prints, Inc.,
14 Plaintiff,
15 v.
16 Shutterfly, Inc.,
17 Defendant.

Case No.
C 08-02050-WJ
COMPLAINT FOR DECLARATORY
RELIEF

DEMAND FOR JURY TRIAL

19 Tiny Prints, Inc. ("Tiny Prints") alleges as follows for its Complaint for
20 Declaratory Relief against Shutterfly, Inc. ("Shutterfly"):

21 1. This is a civil action arising under the Patent Laws of the United States, 35
22 U.S.C. §§ 101, *et seq.*, seeking declaratory judgment that U.S. Patent Nos. 6,583,852 ("the '852
23 patent"), 6,587,596 ("the '596 patent"), and 7,146,575 ("the '575 patent") (collectively "the
24 patents in suit") are invalid, unenforceable, and not infringed by Tiny Prints.

25 **THE PARTIES**

26 2. Plaintiff Tiny Prints is a corporation organized and existing under the laws
27 of California, having a principal place of business at 520 San Antonio Road, Suite 100, Mountain
28 View, California 94040.

1 3. Upon information and belief, Defendant Shutterfly is a corporation
2 organized and existing under the laws of Delaware, having a principal place of business at 2800
3 Bridge Parkway, Suite 101, Redwood City, California 94065.

4 **JURISDICTION AND VENUE**

5 4. Tiny Prints brings this complaint against Shutterfly pursuant to the patent
6 laws of the United States, Title 35 of the United States Code, with a specific remedy sought based
7 upon the laws authorizing actions for declaratory judgment in the courts of the United States, 28
8 U.S.C. §§ 2201 and 2202.

9 5. This Court has subject-matter jurisdiction over Tiny Prints' claims
10 pursuant to 28 U.S.C. §§ 1331, 1338(a), 2201, and 2202. On March 10, 2008, Shutterfly accused
11 Tiny Prints of infringing Shutterfly's patents. Shutterfly specifically accused Tiny Prints of
12 infringing "at least" the '852 and '575 patents and directed Tiny Prints to its patent portfolio
13 regarding its other issued patents, which includes the '596 patent. Tiny Prints is entitled to
14 engage in the activity accused by Shutterfly without the need for a license. Based on the
15 March 10, 2008 letter, the claim charts provided by Shutterfly, and other conduct by Shutterfly,
16 there exists an actual and justiciable controversy of sufficient immediacy between Tiny Prints and
17 Shutterfly regarding the patents in suit such that, absent a declaration of non-infringement,
18 invalidity, and unenforceability, Tiny Prints will suffer irreparable injury and damage as a result
19 of Shutterfly's wrongful assertion of the patents in suit against Tiny Prints.

20 6. Venue is proper in this district pursuant to 28 U.S.C. §§ 1391 and 1400.

21 7. This Court has personal jurisdiction over Shutterfly because it maintains its
22 principal office in this District.

23 **INTRADISTRICT ASSIGNMENT**

24 8. Assignment to the San Jose Division is proper because a substantial part of
25 the events which give rise to the claim occurred in Santa Clara County.

26 **FIRST CAUSE OF ACTION**

27 9. Tiny Prints incorporates by reference and realleges paragraphs 1 through 8
28 above as though fully restated herein.

1 10. Upon information and belief, Shutterfly is the assignee of the '852 patent,
2 entitled "Apparatus, Architecture and Method for High-Speed Printing." The '852 patent was
3 issued on June 24, 2003. A true and correct copy of the '852 patent is attached to this Complaint
4 as Exhibit A.

5 11. Tiny Prints has not infringed, and is not infringing, either directly or
6 indirectly, any claim of the '852 patent.

7 12. One or more claims of the '852 patent is invalid for failure to meet the
8 requirements of the patent laws of the United States, including particularly 35 U.S.C. §§ 101, *et*
9 *seq.*

10 13. The '852 patent is unenforceable due to inequitable conduct.

11 14. Upon information and belief, prior to issuance of the '852 patent, the
12 named inventors and/or others substantively involved in the prosecution of the application leading
13 to the '852 patent (collectively "the '852 applicants"), were aware of information material to the
14 patentability of the claims of the '852 patent, but withheld that information from the Patent Office
15 with the intent to deceive the Patent Office. The withheld information includes at least U.S.
16 Patent No. 6,181,409, which was brought to the attention of the '852 applicants during
17 prosecution of U.S. Patent No. 6,657,702 ("the '702 patent") no later than May 15, 2002. David
18 Baum, a named inventor of the '852 patent, is a named inventor of the '702 patent.

19 15. Upon information and belief, prior to issuance of the '852 patent, the '852
20 applicants were aware of information material to the patentability of the claims of the '852 patent,
21 but withheld that information from the Patent Office with the intent to deceive the Patent Office.
22 The withheld information includes at least U.S. Patent No. 6,278,528, which was brought to the
23 attention of the '852 applicants during the prosecution of U.S. Pat. No. 6,533,169 ("the '169
24 patent") no later than March 18, 2003. Xin Wen, a named inventor of the '852 patent, is a named
25 inventor of the '169 patent.

26 16. Based on Shutterfly's conduct, as described above, asserting its patents
27 against Tiny Prints' products and services despite Tiny Prints' non-infringement, an actual and
28 justiciable controversy of sufficient immediacy exists between Tiny Prints and Shutterfly

1 concerning the non-infringement, invalidity, and unenforceability of the '852 patent. A judicial
2 declaration of non-infringement, invalidity, and unenforceability is necessary and appropriate to
3 resolve this controversy.

4 **SECOND CAUSE OF ACTION**

5 17. Tiny Prints incorporates by reference and realleges paragraphs 1 through 8
6 above as though fully restated herein.

7 18. Upon information and belief, Shutterfly is the assignee of the '596 patent,
8 entitled "System and Method of Cropping an Image." The '596 patent was issued on
9 July 1, 2003. A true and correct copy of the '596 patent is attached to this Complaint as Exhibit
10 B.

11 19. Tiny Prints has not infringed, and is not infringing, either directly or
12 indirectly, any claim of the '596 patent.

13 20. One or more claims of the '596 patent is invalid and/or unenforceable for
14 failure to meet the requirements of the patent laws of the United States, including particularly
15 35 U.S.C. §§ 101, *et seq.*

16 21. Based on Shutterfly's conduct, as described above, asserting its patents
17 against Tiny Prints' products and services despite Tiny Prints' non-infringement, an actual and
18 justiciable controversy of sufficient immediacy exists between Tiny Prints and Shutterfly
19 concerning the non-infringement and invalidity of the '596 patent. A judicial declaration of non-
20 infringement and invalidity is necessary and appropriate to resolve this controversy.

21 **THIRD CAUSE OF ACTION**

22 22. Tiny Prints incorporates by reference and realleges paragraphs 1 through 7
23 above as though fully restated herein.

24 23. Upon information and belief, Shutterfly is the assignee of the '575 patent,
25 entitled "Image Uploading." The '575 patent was issued on December 5, 2006. A true and
26 correct copy of the '575 patent is attached to this Complaint as Exhibit C.

27 24. Tiny Prints has not infringed, and is not infringing, either directly or
28 indirectly, any claim of the '575 patent.

25. One or more claims of the '575 patent is invalid and/or unenforceable for failure to meet the requirements of the patent laws of the United States, including particularly 35 U.S.C. §§ 101, *et seq.*

26. The '575 patent is unenforceable due to inequitable conduct.

27. Upon information and belief, prior to issuance of the '575 patent, the named inventors and/or others substantively involved in the prosecution of the application leading to the '575 patent (collectively "the '575 applicants"), were aware of information material to the patentability of the claims of the '575 patent, but withheld that information from the Patent Office with the intent to deceive the Patent Office. The withheld information includes at least U.S. Patent No. 6,332,146 ("the '146 patent"), which was brought to the attention of the '575 applicants during the prosecution of U.S. Patent No. 6,704,712 ("the '712 patent") no later than March 9, 2004. Shutterfly, the assignee of the '575 patent, is the assignee of the '712 patent. Moreover, the '146 patent was brought to the attention of the '575 applicants during prosecution of U.S. Pat. No. 7,328,173 ("the '173 patent") no later than May 15, 2002. Patrick Teo, a named inventor of the '575 patent, is a named inventor of the '173 patent.

28. Based on Shutterfly's conduct, as described above, asserting its patents against Tiny Prints' products and services despite Tiny Prints' non-infringement, an actual and justiciable controversy of sufficient immediacy exists between Tiny Prints and Shutterfly concerning the non-infringement, invalidity, and unenforceability of the '575 patent. A judicial declaration of non-infringement, invalidity, and unenforceability is necessary and appropriate to resolve this controversy.

PRAYER FOR RELIEF

Plaintiff Tiny Prints, reserving its right to amend its pleading to add additional claims if warranted by discovery in this case, prays that this Court enter a judgment that:

a. Tiny Prints does not infringe, willfully or otherwise, induce infringement of, or contribute to the infringement of the '852 patent, nor has it ever done so;

b. Tiny Prints does not infringe, willfully or otherwise, induce infringement of, or contribute to the infringement of the '596 patent, nor has it ever done so;

c. Tiny Prints does not infringe, willfully or otherwise, induce infringement of, or contribute to the infringement of the '575 patent, nor has it ever done so;

d. The '852 patent is invalid;

e. The '596 patent is invalid;

f. The '575 patent is invalid;

g. The '852 patent is unenforceable due to inequitable conduct;

h. The '575 patent is unenforceable due to inequitable conduct;

i. That this case be declared exceptional under 35 U.S.C. § 285 and that Tiny

Prints be awarded attorneys' fees;

j. For costs of suit, including without limitation, expert consultant and witness fees;

k. That Shutterfly and each of its officers, employees, agents, alter egos, attorneys, and any persons in active concert or participation with it be restrained from further prosecuting or instituting any action against Shutterfly claiming that the '852 patent is valid, enforceable, or infringed, or from representing that Tiny Prints' products or services, or that the use thereof, infringes the '852 patent;

l. That Shutterfly and each of its officers, employees, agents, alter egos, attorneys, and any persons in active concert or participation with it be restrained from further prosecuting or instituting any action against Shutterfly claiming that the '596 patent is valid or infringed, or from representing that Tiny Prints' products or services, or that the use thereof, infringes the '596 patent;

m. That Shutterfly and each of its officers, employees, agents, alter egos, attorneys, and any persons in active concert or participation with it be restrained from further prosecuting or instituting any action against Shutterfly claiming that the '575 patent is valid, enforceable, or infringed, or from representing that Tiny Prints' products or services, or that the use thereof, infringes the '575 patent; and

1 n. For such other and further relief as the Court deems just and proper.

2 **DEMAND FOR JURY TRIAL**

3 Tiny Prints hereby demands a trial by jury on all claims so triable.

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5 Dated: April 18, 2008

WEIL, GOTSHAL & MANGES LLP

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8 By: *Christopher J. Cox*
CHRISTOPHER J. COX
chris.cox@weil.com

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10 Attorneys for Plaintiff
11 Tiny Prints, Inc.

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